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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,791	10/29/2003	Reinhard Deutsch	41653-197865	6085
26694	7590	12/07/2004	EXAMINER	
VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			PURVIS, SUE A	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,791

Applicant(s)

DEUTSCH ET AL.

Examiner

Sue A. Purvis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kronseder (US Patent No. 5,024,348).

Kronseder discloses a magazine assembly in a labeling machine where a means by which labels are procured in a stack or magazine. The supply magazine is replaceable. Transfer plates (47) are part of a universal pick up device which picks up the label from the replaceable magazines. The labels are subsequently applied to an article with the transport plate (47).

Regarding claim interpretation, applicant's use of the alternative language in the claim results in a single feed which is interchangeable either with itself or with a second type of feed, since claims are given their broadest reasonable interpretation consistent with the specification. Figures 1 and 2 of applicant's specification shows the apparatus having two different feeds being capable of being mounted to the machine, but the claim requires either a first feed means "or" a second feed means. It is proper to use the specification to interpret what the applicant meant by a word or phrase recited in the claim. However, it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Intervet America Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050,

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1053, 12 USPQ2d 1474,1476 (Fed. Cir. 1989). Furthermore, applicant's use of "coupon" and "collar" amounts to material worked upon and the "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935). (See MPEP §2115.) The label used in Kronseder are equivalent to applicant's "coupon" and the "collar" is part of the cigarette packet to which the label or coupon is applied.

Regarding claim 25, the feed means in Kronseder includes labels (48) fed from a magazine (3).

3. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Vijuk (US Patent No. 4,812,195).

Vjuk discloses that an important aspect with respect to the folding station (33) the sheets are fed and folded is that sheet station (26) is separate. Therefore, it is possible to substitute the web accumulator (28) and web severing means (31) with a stack sheet feeder having a stack of pre-cut sheets therein and feeding them to the folder. (Col. 7, lines 16-30.) The folding station (33) is considered equivalent to applicant's pickup and application station because it folds the sheet and effectively applies one side of the sheet to another side. Applicant is reminded that use of "coupon" amounts to material worked upon and the "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935). (See MPEP §2115.)

4. Claims 23-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Bright (EP 0 370 633 A1).

Bright discloses a unit for applying labels to packets with first means by which the labels are procured as single items ordered in a stack (Figure 2) or a second means by which to feed slips obtainable as cuts made from a continuous strip (Figures 2 and 3), and a

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universal pickup and application device (19) installed permanently in the machine such as will take up the slips with equal facility from either the first or the second feed means.

Regarding claim 24, the first and second feed means are mutually interchangeable.

Regarding claim 25, the first feed means comprise a magazine (75) containing a plurality of labels ordered in a stack aligned on a relative axis substantially perpendicular to the pickup station.

Regarding claim 26, the second feed means comprise a means which respectively decoil, feed and cut a continuous strip to index the strip.

Regarding claim 27, the pickup and application device (19) moves between the pickup station and a release position.

Regarding claim 28, the pickup assembly (19) comprises a pickup mechanism (it is a vacuum drum).

Regarding claim interpretation, applicant's use of "coupon" and "collar" amounts to material worked upon and the "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935). (See MPEP §2115.) The label used in Kronseder are equivalent to applicant's "coupon" and the "collar" is part of the cigarette packet to which the label or coupon is applied.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bright in view of Focke et al. (US Patent No. 5,203,953) and Voltmer et al. (US Patent No. 4,605,459).

The vacuum drum (19) in Bright includes suction holes which are a functionally equivalent alternative expedient of the applicant's suction cup. Focke shows the same pick up member for both magazine and strip feed means. The pickup member includes suction bores. Voltmer discloses a suction cup (28) being used as a pick up means.

It would have been obvious to one having ordinary skill in the art at the time the invention was made that either suction bores or a suction cup can be used to pick up the label from the feed magazine or the cut feed strip, because both methods are known and used in the art.

Response to Arguments

7. The majority of applicant's arguments address the use of the term "coupon" in place of "slip." The references used by the examiner in the rejection deal with "labels" which are equivalent to a coupon. In some instances the label can be the coupon. In Vijuk, the device applies "outserts," again, theses are considered to be equivalent to a "coupon". Furthermore, "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

8. Applicant goes on to argue that Bright does not teach individual insertion of coupons into "packages." In response to this argument, it must be pointed out that the feature upon

which applicant relies are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). There is no mention of inserting coupons into "packages" in the claims. The claims are drawn to applying coupons to packets.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

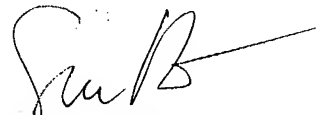
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis
Primary Examiner
Art Unit 1734

SP
December 1, 2004